

U.S. Patent Application
Serial No. 10/584,004

REMARKS

Claims 13, 14, and 25 are currently being amended such that both ethanol and the Lewis base are present in the adducts. The amendments provided herein do not introduce new matter within the meaning of 35 U.S.C. §132. Accordingly, entry of the amendments by the Examiner is respectfully requested.

1. Rejection of Claims 13-15 and 18-25 Under 35 U.S.C. §102(b) to

EP 0 395 083

First and foremost, the instant Office Action has a section titled "Claim Rejections - 35 USC § 102 or 103." However, the only relevant sections of Title 35 enumerated, as well as rejections discussed, outline anticipation rejections and not obviousness rejections. Accordingly, Applicant has interpreted the current Office Action to mean that the only pending rejections are anticipatory in nature, and as such, Applicant respectfully traverses the rejection of claims 13-15 and 18-25 as being anticipated under 35 U.S.C. §102(b) to EP 0 395 083 (herein referred to as "Sacchetti, et al.").

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claims is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of*

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California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

With respect to the instant anticipation rejection, Applicant has amended the currently pending claims such that both ethanol and the Lewis base need to be present in the currently claimed adducts. Alternatively, in *Sacchetti, et al.* the adducts exemplified only have ethanol present. See examples 1-6 in *Sacchetti, et al.*

Nevertheless, as acknowledged by the Examiner, *Sacchetti, et al.* discloses that dealcoholation is carried out until the alcohol content of the adducts is not greater than 2 moles, preferably between 0.15 and 1.5 moles, and particularly preferable between 0.3 and 1.5 moles. See page 3, lines 46-47 in *Sacchetti, et al.* Alternatively, Applicant is claiming adducts in which the ethanol content is from 2 to 6 moles per mole of $MgCl_2$. Accordingly, Applicant is currently claiming adducts having a much higher alcohol content than the adducts of *Sacchetti, et al.*

In light of the above, Applicant respectfully believes the instant rejection to *Sacchetti, et al.* should be withdrawn, and that claims 13-15 and 18-25 are novel and patentably distinct from *Sacchetti, et al.*

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As indicated above, the current Office Action only discusses the instant rejection as anticipatory. Accordingly, Applicant respectfully traverses the rejection of claims 13-15 and 18-25 as being anticipated under 35 U.S.C. §102(e) to U.S. Patent Application Publication 2006/0025300 (herein referred to as "Diego, et al.").

As aptly indicated by the Examiner, the instant rejection can be overcome by a showing that the subject matter relied upon in Diego, et al. and currently claimed in the instant application were derived from the same inventor(s), and thus, was not "by another." In this regard, Applicant has submitted a declaration as ATTACHMENT B herewith this response to obviate the instant rejection.

In light of the above, Applicant respectfully believes the instant rejection to Diego, et al. should be withdrawn, and that claims 13-15 and 18-25 are novel and patentably distinct from Diego, et al.

CONCLUSION

Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and withdraw the pending objection and rejections, and allow claims 13-16 and 18-26. Favorable action with

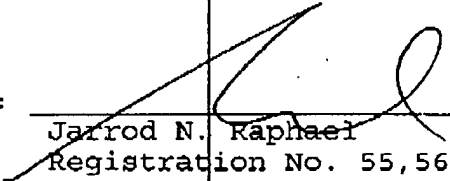
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an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned practitioner if she has any questions or comments.

Respectfully submitted,

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. 571-273-8300) on February 24, 2010.


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